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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/821,243	
	Filing Date	April 7, 2004	
	First Named Inventor	Jeffrey P. WHITTEN	
	Art Unit	1624	
	Examiner Name	K. Habte	
Total Number of Pages in This Submission	6	Attorney Docket Number	532232001100

ENCLOSURES (Check all that apply)				
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply (5 pages) <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Receipt Postcard		
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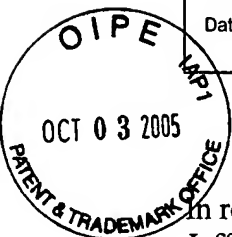
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	MORRISON & FOERSTER LLP		
Signature			
Printed name	Emily C. Tongco		
Date	September 29, 2005	Reg. No.	46,473

I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.	
Dated: September 29, 2005	Signature: (Judy Bridgewater)

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Dated: 9/29/05 Signature: Judy Bridgewater
(Judy Bridgewater)

Docket No.: 532232001100
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jeffrey P. WHITTEN et al.

Application No.: 10/821,243

Filed: April 7, 2004

For: SUBSTITUTED QUINOBENZOXAZINE
ANALOGS

Confirmation No.: 9571

Group Art Unit: 1624

Examiner: K. Habte

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed August 31, 2005, for which the time for response is set to expire September 30, 2005. Therefore, this response is timely filed.

Applicants hereby provisionally elect Group I (claims 1-28 and 41-46) for continued examination, with traverse.

ELECTION OF INVENTION

Claims 1-46 are pending in this application. Restriction has been required as between the following allegedly distinct groups of inventions:

Group I (claims 1-28 (in part) and 41-46 (in part)), drawn to fused morpholine (i.e. $Z = O$), classified in class 544, subclass 99.

Group II (claims 1-28 (in part) and 41-46 (in part)), drawn to fused thiazine (i.e. $Z = S$), classified in class 544, subclass 14.

Group III (claims 1-28 (in part) and 41-46 (in part)), drawn to fused piperazine (i.e. $Z = N$), classified in class 544, subclass 233.

Group IV (claims 1-28 (in part) and 41-46 (in part)), drawn to fused piperidine (i.e. $Z = CH_2$), classified in class 546, subclass 40 and 33.

Group V (claims 29-40), drawn to a method of use, classified in class 514, subclass various.

Applicants hereby elect Group I (claims 1-28 and 41-46), with traverse with respect to the restriction between Groups I, II, III and IV. Applicants expressly reserve their right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

According to MPEP § 803.02, “[i]f the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions.” (emphasis added). Applicants respectfully submit that the members of the Markush group in “Z”

(O, S, NR¹ or CH₂) are sufficiently few that a search and examination of the entire claim can be made without serious burden.

Further, the Office has required restriction between subject matter within each of claims 1-28 and 41-46 as the subject matter of the claims is divided between Groups I, II, III and IV. This practice is impermissible according to controlling legal precedent. *See In re Watkinson*, 14 USPQ.2d 1407 (Fed. Cir. 1990) citing *In re Weber*, 198 USPQ 328, 332 (CCPA 1978) and *In re Haas*, 198 USPQ 334, 336 (CCPA 1978). The courts have definitively ruled the statute authorizing restriction practice (i.e., 35 U.S.C. § 121) provides no authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. In these decisions, the courts expressly ruled there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Office to fashion such a rejection. As noted in *In re Weber* at 334:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim, no matter how broad, which means no matter how many independently patentable inventions may fall within it.

Alleging that a particular claim represents multiple "patentably distinct" inventions is a *de facto* rejection of the patentability of the claim because the claim cannot issue as drafted. In this regard the court noted in *In re Weber*, *supra*:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not effect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim will never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of fragments would not be described in the specification (emphasis added).

Instead of improperly imposing restriction of a given claim, the Office may limit initial examination to a "reasonable number" of species encompassed by the claim (see 37 C.F.R. § 1.146). This practice strikes an appropriate balance between administrative concerns of the Office and the clear constitutional and statutory rights of the inventor to claim an invention as it is contemplated. See MPEP at § 803.02; *In re Wolfrum*, 179 USPQ 620 (CCPA 1973); and *In re Kuehl*, 177 USPQ 250 (CCPA 1973). Unlike a restriction requirement, a species election does not preclude an applicant from pursuing the original form of a claim in subsequent prosecution nor does it force an Applicant to file multiple divisional applications that are incapable of capturing the intended scope of the application. In addition, with a species election, the provisions of 37 C.F.R. § 1.141(a) to additional species may be applied upon allowance of a generic claim.

Here, it should be clear that the added cost of filing and prosecuting four patent applications does not strike an appropriate balance between the administrative concerns of the Office and the Applicants' statutory rights as inventors. Thus, restriction between subject matter of Groups I to IV is impermissible according to controlling legal precedent, and it is respectfully requested that the Office examine the subject matter of claims 1-28 and 41-46 in full.

CONCLUSION

Applicants request reconsideration of the restriction requirement and examination of the elected subject matter on the merits.

In the unlikely event that the transmittal form is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 532232001100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: September 29, 2005

Respectfully submitted,

By 
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